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MICHAEL D. BECK; BAKER & DANIELS
300 N. MERIDIAN STREET
SUITE 2700
INDIANAPOLIS, IN 46204

EXAMINER

PARDO, THUY N

38

ART UNIT PAPER NUMBER

2175

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Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 2175



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JUL 26 2002

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Technology Center 2100

Paper No. 38

Application Number: 09/100,934

Filing Date: June 22, 1998

Appellant(s): STOUT, WESLEY

Michael Beck, Registration No. 32, 722

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on February 20, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

The rejection of claims 5 and 6 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(9) Prior Art of Record**5,761,668****Adamchick****6-1998****(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:
Claims 5 and 6 are rejected under 35 U.S.C. § 103 as being unpatentable over Adamchick US Patent No. 5,761,668.

(11) Response to Argument

(A) (1) Applicant argues that the reliance upon "well-known" facts was in error and claims 5 and 6 are Non-Obvious. As to this point, Examiner respectfully disagrees. As to claims 5 and 6. Examiner believes that the combination of the "well-known" facts and Adamchick's teachings will cover all limitations of claimed invention. Adamchick teaches a computer readable memory storage medium, said medium storing a plurality of date files, each said date file having 6 integers [ab; six numeric characters, 221-226 of fig. 2; col. 4, lines 54-63] and comprising a 4 digit decimal year represented in a first three integer form [221, 222, and 223 of fig. 2], the last two of said first three said integers representing the last two digits of the 4 digit decimal year [222 and 223 of fig.

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2], the first of said first three said integers representing a designated century [C 221 of fig. 2], a 3 digit decimal day represented in a second three integer form, said second three integers representing a day of a year [224, 225, and 226 of fig. 2]; whereupon addition to or subtraction of at least two of said plurality of date files, the respective sums and differences can be computed and maintained after year 1999 [Millennium Date, col. 4, lines 64 to col. 5, lines 18]; and a central processing unit for carrying out said addition and said subtraction operations [inherent in the computer system for carrying out the operation in col. 6, lines 4-60]. However Adamchick does not explicitly teach adding said integers of one of said plurality of files to another of said plurality of files to generate a sum, and optionally; whenever necessary, adding 635 to said sum. However, this feature of adding an integer to another numbers to generate a sum is well-known in the art and well-applied in many exclusively operations. For example, odometers and other registers turn over when they are full by adding 5 to a 3-digit register containing 999 will produce 004. In this case, the three digit decimal number of the claim is used to represent the day of a 365-day of a year. Thus, adding 5 to 364 would yield 369, not the desired 004. The addition of 635 turns a module-1000 register into a module-365 register. It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to add 635 to the sum as needed because it would make a decimal register into a year-day register.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant fails to recognize to the level of skill in the art. A format is claimed which enables an arithmetic, and is the same as that taught by Adamchick. Clearly the same capability follows from the common format and would be recognized by one of ordinary skill. Further, the point of data file is to use the dates for calculations. The seven digits from claim 3 merely uses the standard year format, 1999, 2000, 2001, ...etc, which provides for no year compressions. The seven digit Julian date is known in Adamchick [col. 4, lines 28-32].

(B) Applicant raises the issue concerning the propriety of refusing consideration of Mr. Stout's three declarations and accompanying documentary evidence.

As to this point, Examiner believes that the exhibit is, as stated in the Declaration, an act of conception but not a reduction to practice. Applicant relies on filing of the application for constructive reduction to practice on June 22, 1998. Examiner believes that the claim of diligence is not complete (see MPEP 2138.06), "An applicant must account for the entire period during which diligence is required. *Gould v. Shawlow*, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough); *In re Harry*, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not showing but a mere pleading)". In particular, the entire initial period must start prior March 08, 1996 and show diligence up to the part of reduction to practice,

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June 22, 1998. Dates must be established for items such as the effects of the surgery.

Applicant's Declaration and Response filed on February 06, 2001 in response to Examiner's Advisory Action. Examiner believes that the exhibit is, as stated in the Declaration, an act of contacting with several companies, organization, and government agencies but not a reduction of the complete invention to practice, and does not demonstrate diligence in that regard. The submitted Declaration is addressed to offer for use or sale, not to reduction of invention to practice.

Applicant's Declaration and Response filed on February 06, 2001. Examiner believes the exhibit is, as stated in the Declaration, an act of contacting with several companies, organization, and government agencies but not a reduction of the complete invention to practice, and does not demonstrate diligence in that regard. The submitted Declaration is addressed to offer for use or sale, not to reduction of invention to practice. The claim of diligence is not complete (see MPEP 2138.06), "An applicant must account for the entire period during which diligence is required. *Gould v. Shawlow*, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough); *In re Harry*, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not showing but a mere pleading)". In particular, the entire initial period must start prior March 08, 1996 and show diligence up to the part of reduction of the complete invention to practice, June 22, 1998. Dates must be established for items such as the effects of the surgery.

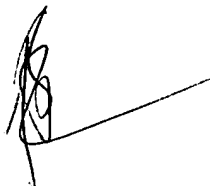
Applicant's Request for Consideration filed on November 29, 2000. Examiner also believes the exhibit is, as stated in the Declaration, an act of conception but not a

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reduction to practice. Applicant relies on filing of the application for constructive reduction to practice on June 22, 1998. The claim of diligence is not complete (see MPEP 2138.06), "An applicant must account for the entire period during which diligence is required. *Gould v. Shawlow*, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough); *In re Harry*, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not showing but a mere pleading)". In particular, the entire initial period must start prior March 08, 1996 and show diligence up to the part of reduction to practice, June 22, 1998. Dates must be established for items such as the effects of the surgery.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Thuy Pardo
August 20, 2002


WAYNE AMSBURY
PRIMARY PATENT EXAMINER
CHARLES RONES
PRIMARY EXAMINER